

REMARKS

Reconsideration is respectfully requested in view of any changes to the claims and the remarks herein. Please contact the undersigned to conduct a telephone interview in accordance with MPEP 713.01 to resolve any remaining requirements and/or issues prior to sending another Office Action. Relevant portions of MPEP 713.01 are included on the signature page of this amendment.

DRAWINGS

The Examiner at page 2 of the Office Action states, Fig. 1 should be labeled prior art. The Examiner gives no reason for this request. Applicants disagree that Fig. 1 should be labeled prior art.

Fig. 2 has been objected to since it includes ref. no. 20. In response thereto the specification has been amended at page 4 to include a reference to ref. no. 20.

Fig. 15 has been has been objected to since it includes ref. nos. 200 and 202. In response thereto the specification has been amended at page 7 to include a reference to ref. nos. 200 and 202.

Fig. 16 has been added and text at page 3 of the specification has been added corresponding thereto to show claim 13 in the drawings.

In view of the above remarks applicants respectfully request the drawing objections be withdrawn.

Claim Objections

The Examiner has objected to claims 2-31 stating "the preamble in each claim are improperly representing antecedent basis." Applicants respectfully disagree. In the

preliminary amendment filed with the application, the claim 1 preamble states “A structure comprising” and each of claims 2-31 recite “A structure according to claim...”. Applicants respectfully request this objection be withdrawn.

Claim Rejections Under 35 USC 112, First Paragraph

Claims 18-19 and 30-31 have been rejected under 35 USC 112, first paragraph, for failing to comply with the written description requirement. Applicants respectfully disagree. Claims 18 and 19 were filed with the original application No. 09/164,470, of which the present application is a division thereof. Claim 30 and 31 are based on claims 18 and 19. Thus there is written description support for claim 18-19 and 30-31. In view thereof applicants respectfully request withdrawal of this rejection.

Claim 20 and 22-25 have been rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states “claim 20 recites wherein said sheet comprises of a material. The only support for such materials is made known in the instant application on pg. 8, lines 1-2. Found in app. serial no. 07/963,346, U.S. Pat. No. 5,371,654 at col. 8, lines 20-26.” Applicants respectfully disagree, claims 20 and 22-25 are original claims and are thereby supported by the specification. The Examiner further states that applicants do not teach “the sheet having a plurality of openings therein through which said flying lead wires project” as recited in claim 8. Applicants respectfully disagree. Applicants’ Fig. 14 clearly supports this recitation. The Examiner further states “that claim 10-16 suggest that the sheet is spaced apart from the substrate and does not form as a portion of the substrate. Therefore, the Examiner could not find any compelling evidence(s) that the sheet as recited in claim 20 is described by the Applicant at the time of the invention.” Applicants respectfully disagree. Applicants note that claim 20 is an originally filed claim and thus provides support for itself and that Fig. 14 shows sheet 153 spaced apart from component 11.

The Examiner further states “[a]ssuming arguendo, claims 20 and 22-25 were proper under 35 USC 112, first paragraph, the disclosures of U.S. Pat. No 5,371,654 and U.S. Pat. No. 5,635,846 may teach the limitations of claims 20 and 22-25.

Applicants have submitted a corrected claim of priority herewith which adds the claim of priority to U.S. 5,635,846 and U.S. 5,371,654 both of which are incorporated by reference in the specification at page 8, lines 1 and 2. Applicants note that U.S. Application Serial No. 09/688,394 incorporated by reference at page 8, line 1, is a division of Application Serial No. 08/754,869, filed 11/22/1996, which is a continuation of Application Serial No. 08/055,485, filed 04/30/1993, which issued as U.S. Patent No. 5,635,846.

In view of the remarks above Applicants respectfully request that the rejection of claims 18-19, 20, 22-25 and 30-31 under 35 USC 112, first paragraph, be withdrawn.

Rejections Under 35 USC 112, Second Paragraph

Claim 5-25 and 27-31 have been rejected under 35 USC 112, second paragraph. Claims 5, 9, 10 and 12 have been amended to clarify the issues cited by the Examiner and in view thereof Applicants respectfully request this rejection be withdrawn.

Claim Rejections Under 35 USC 102

Claims 1-4, 8-14, 16-19, 21 and 27-31 have been rejected under 35 USC 102(e) as anticipated by U.S. Pat. No. 5,635,846. In view of this patent having been incorporated by reference as recited above and the amended claim of priority to this patent submitted herewith, Applicants respectfully request this rejection be withdrawn. Since the present specification includes the teaching of U.S. 5,635,846 and claims priority to it, it is not prior art to the rejected claims.

Claim Rejections Under 35 USC 103

All claims of the present application are commonly owned at the time of this invention.

Claims 5-7 have been rejected as obvious over U.S. 5,635,846 and claims 15, 20 and 22-25 have been rejected as obvious over U.S. Patent 5,371,654. In view of the incorporation by reference of both of these patents as noted above and the amended claims of priority to both of these patents submitted herewith applicants respectfully request withdrawal of this rejection.

Applicants note U.S. 5,635,846, teaches at Col. 6, lines 9-19,

FIG. 8 shows the ball bonding head 124 withdrawn in the direction indicated by arrow 128 from the pad 106 and the wire 126 drawn out to leave disposed on the pad 106 surface 122 wire 130. ... The bond wire is positioned at an angle preferably between 5.degree. to 60.degree. from vertical and then mechanically notched (or nicked) by knife edge 134 as shown in FIG. 9. The knife edge 134 is actuated, the wire 126 is clamped and the bond head 124 is raised. The wire is pulled up and breaks at the notch or nick.

U.S. 5,635,846 claims priority to U.S. 5,371,654 which is incorporated by reference at Col.4, lines 31-35.

Thus applicants teaching supports the claims presented since the teachings of U.S. 5,635,846 and U.S. 5,371,654 are incorporated within the present application and priority is claimed thereto.

In view of the changes to the claims and the remarks herein, the Examiner is respectfully requested to reconsider the above-identified application. If the Examiner wishes to discuss the application further, or if additional information would be required, the undersigned will cooperate fully to assist in the prosecution of this application. Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

If the above-identified Examiner's Action is a final Action, and if the above-identified application will be abandoned without further action by applicants, applicants file a Notice of Appeal to the Board of Appeals and Interferences appealing the final rejection of the claims in the above-identified Examiner's Action. Please charge deposit account 09-0468 any fee necessary to enter such Notice of Appeal. In the event that this amendment does not result in allowance of all such claims, the undersigned attorney respectfully requests a telephone interview at the Examiner's earliest convenience.

MPEP 713.01 states in part as follows:

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, ... the examiner, as soon as he or she has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Please charge any fee necessary to enter this paper and any previous paper to deposit account 09-0468.

Respectfully submitted,

By: /Daniel P. Morris/
Dr. Daniel P. Morris, Esq.
Reg. No. 32,053
Phone No. (914) 945-3217

IBM Corporation
Intellectual Property Law Dept.
P. O. Box 218
Yorktown Heights, New York 10598